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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/237,828	01/27/1999	JOHN S. HENDRICKS	02688.00008	7008
4372 7590 10/03/2007 ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER TRAN, QUOC A	
			ART UNIT 2176	PAPER NUMBER
			NOTIFICATION DATE 10/03/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/237,828	HENDRICKS ET AL.	
	Examiner	Art Unit	
	Tran A. Quoc	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,20-25,30-44,48-55,80-90,92-108 and 112 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 92-101,103-108 and 112 is/are rejected.
- 7) ☒ Claim(s) 1,20-25,30-44,48-55,80-90,100 and 102 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/01/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Applicant's Response***

In Applicant's Response dated 07/05/2007, Applicant amended Claims 1, 20-25, 30, 32-36, 39, 42-43, 80, 86, 92-93, 95, 98-106, 111, and cancelled claims 2-19, 26-29, 45-47, 56-79, 91, and 109-110, and argued against all rejections previously set forth in the Office Action dated 03/05/2007.

Presently, claims 1, 20-25, 30-44, 48-55, 80-90, 92-108, and 112 are pending in the present application.

Objects to claims 1, 19-25, 30, 32-36, 39, 42-43, 48-49, 50-54, 91-93, 95, 98-102, and 109 previously presented in the Office Action mailed 03/05/2007 have been withdrawn due to Applicants amendments filed 07/05/2007.

Claims 92-95 and 98-100 are rejected under 35 U.S.C. 101, have been withdrawn due to Applicants amendments filed 07/05/2007.

Claims 1, 19-25, 80-85, 91 and 102-108 are rejected under 35 U.S.C. 112, first paragraph, have been withdrawn due to Applicants amendments filed 07/05/2007.

Claims 30, 33-44 and 51-55 are rejected under 35 U.S.C. 112, second paragraph, have been withdrawn due to Applicants amendments filed 07/05/2007.

It is noted the claimed limitations of claims 92-101, 103-108, and 112 is not benefit from the CIP of 08/336,247; 08/160,194; 08/906,469, and 08/160,281, thus the effective filling dated for claims 92-101, 103-108, and 112 is 01/27/1999, evidence is based upon the current application disclosure Vs all the CIP No. 08/336,247; 08/160,194; 08/906,469, and 08/160,281, disclosures, (see the current

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applicant disclosure at Page 4. Lines 26-27, discloses the ***electronic links using HTML (Hypertext Markup Language)***, which was not previously disclose anywhere in all of CIP application disclosure.

### ***Information Disclosure Statement***

A signed and dated copy of applicant's IDS, which was filed on 08/01/2007, is attached to this Office Action.

### ***Allowable Subject Matter***

Claims 1, 20-25, 30-44, 48-55, 80-90, and 102 are allowed.

### ***Claim Objections***

Claim 100 is objected to because of the following informalities:

The phrase "*the plurality of links are purchasable separately from the electronic book*" in Lines 5-6 Page 15 should be amended to — the list of available books as the plurality of links are purchasable separately from the electronic book as an electronic book, because one can not buy the link, but can buy the content of the link.

Appropriate correction is required.

**Claims Rejections – 35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**Claims 92-101, 103-108, and 112 are rejected under 35 U.S.C. 102 (e) as being anticipated by Eberhard et al. US006331867B1 filed 08/28/1998 (hereinafter, "Eberhard").**

**Independent claim 92**, Eberhard teaches:

an electronic book viewer; an electronic book, the electronic book  
information stored in a computer readable medium in the electronic book  
viewer;

(See Eberhard Fig. 4 and Column 6, Lines 40-55, discloses an electronic book view  
device includes titles from memory.

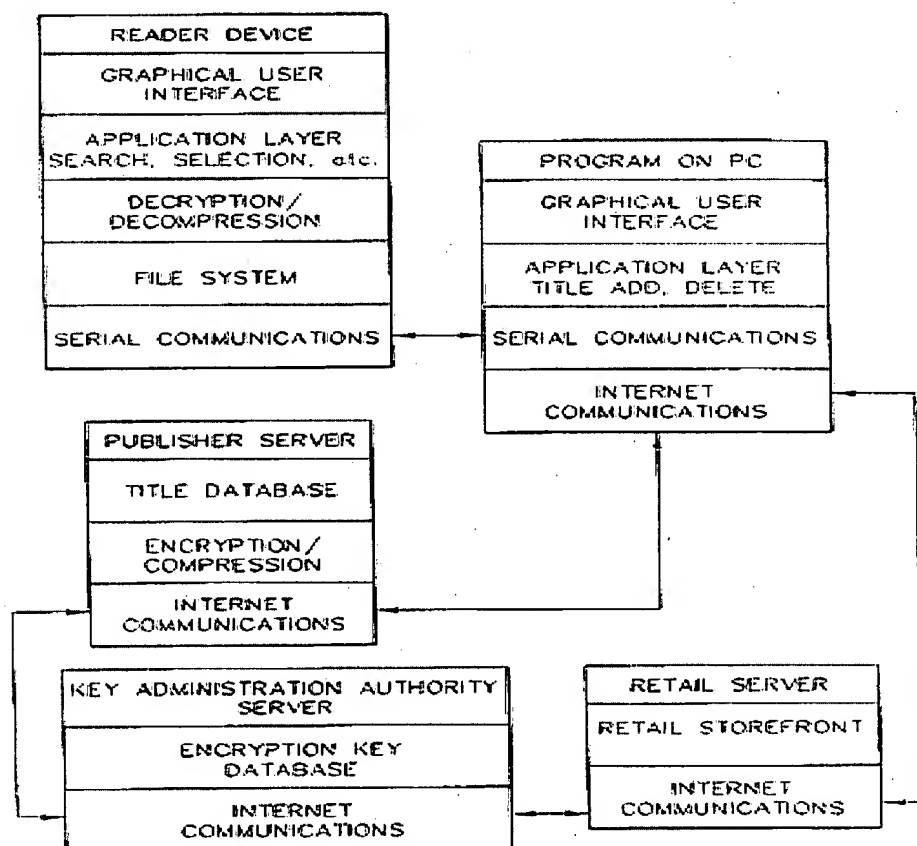


FIG. 4

**and links among components of the electronic book; wherein when  
the links are activated,**

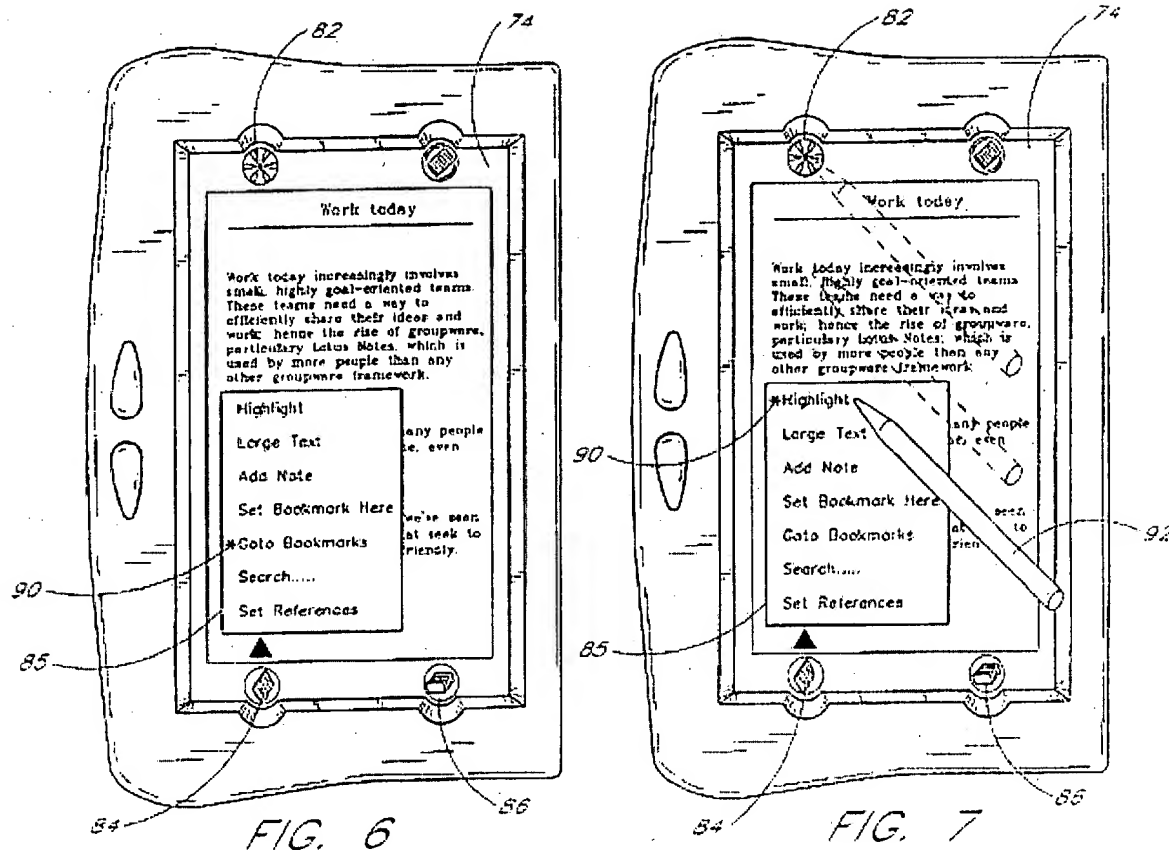
(See Eberhard Column 4, Lines 65-67, discloses HTML (HyperText Markup Language),  
uses of hyperlinks to navigate within and between titles.)

**a first component is linked to a second component; wherein the first  
component is located in the electronic book;**

(See Eberhard Fig. 6-7 and Column 6, Lines 35-40, discloses a book menu key item 84  
and library key when user selected the menu key the device 30 displays a book menu.)

**and wherein the second component is located in a data repository at  
a distant operations center; and wherein selection of the first component  
causes the second component to be displayed on the electronic book  
viewer.**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser  
plug-in (first component), provides functionally for allowing a user to interactively  
purchase and download titles (second component) from Web sites. The PC 31 may also  
run a client application, which retrieves free and/or subscription titles automatically  
(such as by implementing a "push" protocol) from network sites based on pre-specified  
preferences or subscription profiles of the user reference titles.)



**Independent claim 93,**

the rejection of claim 92 is fully incorporated.

In addition, Eberhard teaches:

**wherein the second component is located in a distant data repository  
accessible by a server on a network;**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically



(such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.)

**Claim 94:** Eberhard teaches:

**wherein the network is the Internet.**

(See Eberhard at the Abstract, discloses reader device for viewing, using software which runs on a personal computer (PC), where the user can download titles from Internet sites to the PC.)

**Independent claim 95,**

the rejection of claim 92 is fully incorporated.

In addition, Eberhard teaches:

**wherein the data repository including a list of available books related to the first component, wherein at least one of the books may be ordered for delivery;**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.

See also Eberhard Column 4, Lines 65-67, discloses HTML (HyperText Markup Language), uses of hyperlinks to navigate within and between titles.)

**Claim 96:** Eberhard teaches:

**wherein the electronic books are delivered by transmission via a telecommunications medium.**

(See Eberhard at the Abstract, discloses reader device for viewing, using software which runs on a personal computer (PC), where the user can download titles from Internet sites to the PC.)

**Claim 97,** Eberhard teaches:

**wherein the telecommunications medium is selected from a group consisting of a publicly switched telephone network, a cable television system, a wireless telephone system, a digital;**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.

***Independent claim 98,***

the rejection of claim 92 is fully incorporated,

In addition, Eberhard teaches:

**wherein the second component is a network site including an  
address of one or more news groups related to the first component;**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites.

***Claim 99,***

the rejection of claim 95 is fully incorporated, which cites above, and is similarly rejected under the same rationale.

***Claim 100,*** Eberhard teaches:

**wherein the plurality of links are purchasable separately from the  
electronic book.**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.

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Also see Eberhard Column 4, Lines 65-67, discloses HTML (HyperText Markup Language), uses of hyperlinks to navigate within and between titles.

And See Eberhard Fig. 6-7 and Column 6, Lines 35-40, discloses a book menu key item 84 and library key when user selected the menu key the device 30 displays a book menu.)

**Claim 101**, Eberhard teaches:

**wherein the plurality of links are transmit separately from the electronic book.**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.

Also see Eberhard Column 4, Lines 65-67, discloses HTML (HyperText Markup Language), uses of hyperlinks to navigate within and between titles.

And See Eberhard Fig. 6-7 and Column 6, Lines 35-40, discloses a book menu key item 84 and library key when user selected the menu key the device 30 displays a book menu.)

***Independent claim 103,***

the rejection of claim 95 is fully incorporated,

In addition, Eberhard teaches:

**Is playing a linked first component as a piece of actual text of the electronic book; selecting the linked first component; and displaying a second component linked to the first component,**

(See Eberhard Column 6, table 1, discloses text, book menu and goto bookmark, where bookmarks (index) and a set bookmarks selected define by user.)

***Claim 104,*** Eberhard teaches:

**wherein a third component is selectable via a links menu, and wherein selecting the third component displays the third component, the third component being related to the first component of the electronic book.**

(See Eberhard Column 6, table 1, discloses text, book menu and goto bookmark, where bookmarks (index) and a set bookmarks selected define by user.

Also see Eberhard Fig. 6-7 and Column 6, Lines 35-40, discloses a book menu key item 84 and library key when user selected the menu key the device 30 displays a book menu.)

**Claim 105**, Eberhard teaches:

**wherein the second component is located in the data repository at  
an operations center.**

(See Eberhard Column 4 Line 25-45, discloses from Internet and other network sites to the PC, and subsequently transfer these titles to the device 30 for viewing. The device 30 may additionally or alternatively be provided with browser software and a modem for allowing the user to download titles to the device directly. Titles may additionally or alternatively be retrieved by the PC from a physical storage medium, such as CD-ROM or a DVD disk.)

**Claim 106**, Eberhard teaches:

**wherein the second component is located in the data repository  
accessible by a server on a network.**

(See Eberhard Column 4 Line 25-45, discloses from Internet and other network sites to the PC, and subsequently transfer these titles to the device 30 for viewing. The device 30 may additionally or alternatively be provided with browser software and a modem for allowing the user to download titles to the device directly. Titles may additionally or alternatively be retrieved by the PC from a physical storage medium, such as CD-ROM or a DVD disk.)

**Claim 107**, Eberhard teaches:

**wherein the network is the Internet.**

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(See Eberhard Column 4 Line 25-45, discloses from Internet and other network sites to the PC, and subsequently transfer these titles to the device 30 for viewing. The device 30.)

**Claim 108**, Eberhard teaches:

**wherein the second component is a network site including an address of one or more news groups related to the first component.**

(See Eberhard Column 4 Line 25-45, discloses from Internet and other network sites (ie. Address) to the PC, and subsequently transfer these titles to the device 30 for viewing. The device 30.)

**Independent claim 111,**

the rejection of claim 92 is fully incorporated,

In addition, Eberhard teaches:

**wherein links linking the first and the second components are refreshed by data provided by an external facility,**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.

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Also see Eberhard Column 1, Lines 50-65, discloses automatic look-up feature which can be invoked by the user to look up a word of a displayed title and displaying the results on the display. The reference titles can be downloaded to the device by the user, and can be designated for use with specific literary titles using the device's user interface.)

**Claim 112**, Eberhard teaches:

**wherein the external facility is one of an operations center and a network site.**

(See Eberhard Column 4, Lines 25-65, discloses the HTML as hyperlink as browser plug-in (first component), provides functionally for allowing a user to interactively purchase and download titles (second component) from Web sites. The PC 31 may also run a client application, which retrieves free and/or subscription titles automatically (such as by implementing a "push" protocol) from network sites based on pre-specified preferences or subscription profiles of the user reference titles.)

It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.



***Response to Argument***

Applicant's Remarks filed on 07/05/2007 with respect to claim 1, 20-25, 30-44, 48-55, 80-90, 92-108, and 112 have been considered but are moot in view of the new ground(s) of rejection. This office action is a Final Rejection, because Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action (see above rejection for details).

***Conclusion***

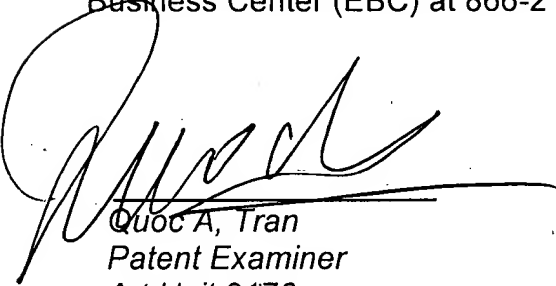
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quoc A. Tran  
Patent Examiner  
Art Unit 2176  
09/25/2007

*/Doug Hutton/*  
Supervisory Primary Examiner  
Technology Center 2100